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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO		
09/401,004	09/21/1999	HENGYUAN LANG	P-HP-3589			
	590 05/19/2003					
LAW OFFICE OF DAVID SPOLTER 1590 COAST WALK			EXAMINER			
LA JOLLA, CA	A 92037		BAKER, MAURIE GARCIA			
			ART UNIT	PAPER NUMBER		
			1639			
			DATE MAILED: 05/19/2003	. ~		

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary		Application No. Applicant(s)				
		09/401,004	Lang et al			
		Examiner Maurie G. Baker	Ph.D.	Art Unit 1639		
	The MAILING DATE of this communication appears	on the cover sheet wi	th the corre	Spondence add	ress -	
	i for Reply				e33	
- Extermail - If th - If NO - Failu - Any	HORTENED STATUTORY PERIOD FOR REPLY IS SET MAILING DATE OF THIS COMMUNICATION. Insions of time may be available under the provisions of 37 CFR 1.136 (a). In ing date of this communication. In period for reply specified above is less than thirty (30) days, a reply within to period for reply is specified above, the maximum statutory period will apply ree to reply within the set or extended period for reply will, by statute, cause the reply received by the Office later than three months after the mailing date of adaptent term adjustment. See 37 CFR 1.704(b).	n no event, however, may a rep the statutory minimum of thirty and will expire SIX (6) MONTH	ly be timely filed (30) days will b	e considered timely. ng date of this comm		
Status						
1) X	Responsive to communication(s) filed on Feb 12, 2	2003				
2a) 🗶		tion is non-final.			· ·	
	Since this application is in condition for allowance closed in accordance with the practice under Ex pa	except for formal mat orte Quayle, 1935 C.E	ters, prose). 11; 453	cution as to th O.G. 213.	e merits is	
	ition of Claims					
	Claim(s) <u>17-36 and 38-48</u>					
	4a) Of the above, claim(s) <u>23, 24, 27-34, 41, and 40</u>	6-48	is/ar	e withdrawn fr	om consideration.	
5) "	Claim(s)			is/are allowed.		
6) X	Claim(s) 17-22, 25, 35, 36, 38-40, and 42-45			is/are rejected.		
7) 🗶	Claim(s) <u>26</u>			is/are objected	to	
8) 🗔	Claims	are subjec	t to restric	tion and/or elec	ction requirement	
Applica	ation Papers	•			stron requirement.	
9) 🗔	The specification is objected to by the Examiner.					
10)	The drawing(s) filed on is/are	a) accepted or b)	objected	d to by the Exa	aminer.	
	Applicant may not request that any objection to the di	rawing(s) be held in abo	evance. See	37 CFR 1 85/a	A.	
11)	The proposed drawing correction filed on	is: a)	approved	b) disapprovi	ed by the Examiner.	
	If approved, corrected drawings are required in reply t	o this Office action.		, ,	-, -, -, -, -, -, -, -, -, -, -, -, -, -	
12)	and outs, or decided for is objected to by the Examin	ner.				
	under 35 U.S.C. §§ 119 and 120					
13): :	Acknowledgement is made of a claim for foreign pri	ority under 35 U.S.C.	§ 119(a)-	(d) or (f).		
	All b) Some* c) None of:					
	1. Certified copies of the priority documents have					
	Certified copies of the priority documents have	been received in App	olication No).	_	
	 Copies of the certified copies of the priority do application from the International Burea 	cuments have been re	eceived in t	his National St	:age	
14)	ee the attached detailed Office action for a list of the	certified copies not re	eceived.			
a)	Acknowledgement is made of a claim for domestic p	priority under 35 U.S.	C. § 119(e).		
	The translation of the foreign language provisional Acknowledgement is made of a claim for democratic	application has been	received.			
Attachme	Acknowledgement is made of a claim for domestic pent(s)	priority under 35 U.S.	C. §§ 120	and/or 121.		
	in at Defense of the control of the	1) Interview Comment	410) 5			
	on of Death-warrant Barrier	Interview Summary (PTO-413) Paper No(s). Notice of Informal Patent Application (PTO-152)				
	rmation Disclosure Statement(s) (PTO-1449) Paper No(s). 20	31 Others	Application (P)	U-152)		

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DETAILED ACTION

Please note: The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to **Art Unit 1639**.

1. The Responses filed September 24, 2002 (Paper No. 22) and February 12, 2003 (Paper No. 26) are acknowledged. In Paper No. 22 claims 17-25 were amended, claims 42-48 were added and claims 16 and 37 were cancelled. Therefore, claims 17-36 and 38-48 are pending.

Election/Restriction

2. Claims 23, 24, 27-30 and 41 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected species, the requirement having been traversed in Paper No. 14. Newly added claims 46 and 47 do not read on the elected species and are also withdrawn. Also please note MPEP § 803.02 (emphasis added) with respect to species elections and Final Office Actions:

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

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the following:

3. Applicant has requested that claims 31-34 and newly added 48 directed to methods of making single compounds be rejoined with the product claims as per MPEP 821.04. However, this provision only takes effect when the product claim is found to be allowable. The product claims are not currently deemed to be allowable. Note rejoinder is only appropriate when the scope of the product and process claims is *identical*; note

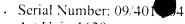
Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), claims directed to the process of making or using a patentable product, previously withdrawn from consideration as a result of a restriction requirement would be subject to being rejoined at such time as the product becomes allowable. Note that process claims which do not depend from or otherwise include *all the limitations of the allowable product* will not be subject to being rejoined.

Therefore, claims 31-34 and newly added 48 remain withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to non-elected inventions.

4. Newly added claims 42-45 read on the elected species and are included in the examination. Thus, claims 17-22, 25, 26, 35, 36, 38-40 and 42-45 are examined on the merits in this action.

Status of Rejections

5. The rejections under 35 U.S.C. 102 over Kenney et al and Miyachi et al are withdrawn in view of applicant's claim amendments. The rejection under 35 U.S.C. 112, second paragraph is also withdrawn, in light of applicant's arguments.



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Maintained Rejections Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(e) of this title before the invention thereof by the applicant for patent.

7. Claims 17-22, 25, 35, 36, 38-40 and 42-45 are rejected under 35 U.S.C. 102(e) as being anticipated by Girten et al (US 6,284,735).

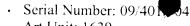
Girten et al disclose compounds that read directly on those claimed. See Compounds A to D as disclosed in columns 8 (beginning on line 37) through 9 where four compounds reading on those of the claims are specifically shown. These compounds read on the instant claims when R^1 , R^2 and R^4 of the claims are H; R^6 = substituted methylene (D = substituted alkylene and W & E absent; substituents are substituted alkyl); and R^7 and R^8 are H. The compounds of Girten et al read on the instant R^3 group when it is $-(C)ONR^{11}R^{12}$, with R^{11} and R^{12} = H and/or substituted alkyl (substituents are phenyl). Furthermore, these compounds are substituted at the instant R^5 position with substituted phenyl groups, reading on the instant claims.

Response to Arguments

8. Applicant's arguments filed September 24, 2002 have been fully considered but are not found persuasive. The examiner's rationale is set forth below.

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- 9. Applicant argues that the Declaration under 37 CFR 1.131 filed September 24, 2002 is sufficient to antedate the Girten et al reference. The examiner respectfully disagrees for the following two reasons.
 - (1) The Declaration filed under 37 CFR 1.131 is deficient because all inventors must sign a 1.131 Declaration, not just a single member of the inventive entity. Furthermore, the rule requires an averment that the invention was made in the United States, a NAFTA country or a WTO country.
 - (2) Importantly, MPEP 715.03 Section B. should be considered as the Girten et al reference discloses several species that read on the claimed genus. The principle is well established that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining a "generic claim." *In re Gosteli*, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989); *In re Slayter*, 276 F.2d 408, 125 USPQ 345 (CCPA 1960). A reference or activity which discloses several species of a claimed genus can be overcome directly under 37 CFR 1.131 only by a showing that the applicant completed, prior to the date of the reference or activity, all of the species shown in the reference. *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957). As this has not been done, the Declaration filed under 37 CFR 1.131 is deficient in its showing.



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Status of Claims/Conclusion

- 10. No claims are allowed. However, claim 26 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner is on an increased flextime schedule but can normally be reached on Monday-Thursday and alternate Fridays from 9:30 to 7:00.

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13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306-3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D. May 14, 2003

HALPRE GANCIE CANCER THE PRIMARY EXAMINER